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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,223	10/28/2003	Perriann M. Holden	810101-3	4944
33651	7590	08/10/2006	EXAMINER	
JERRY RICHARD POTTS 3248 VIA RIBERA ESCONDIDO, CA 92029			HOEY, ALISSA L	
			ART UNIT	PAPER NUMBER
			3765	

DATE MAILED: 08/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/695,223	HOLDEN, PERRIANN M. <i>C</i>
	Examiner Alissa L. Hoey	Art Unit 3765

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 04 August 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 4,19,20,30 and 31 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,5,13-18,21-24,26-29 and 32-35 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Response to Amendment

This is in response to amendment of 04/29/06. A notice of non-compliant amendment was sent out on 05/09/06. A response was received on 05/15/06 correcting the drawing problems. Claims 1, 5, 13-18 and 21-24, 26-29 and 32-35 are pending in this case with claims 4, 19, 20 and 30, 31 withdrawn at this time. Claims 2, 3, 6-12 and 25 have been cancelled. Claims 1, 21, 22, 23, 24 and 32 have been amended. Claims 1, 5, 13-18, 21-24, 26-29 and 32-35 are examined below.

Priority

1. The amendment of the priority statement in the specification has been entered with respect to application serial no. 09/910,641.

Specification

2. The objection with respect to the related applications section from the originally filed specification and the present is understood by the examiner. To avoid confusion the originally filed specification of 10/28/03 states "This application is a divisional of a continuation-in-part of U.S. Serial No....." The specification of 03/18/05 and 06/17/05 states "This application is a continuation-in-part of a provisional application US Serial....." The current amendment to the specification states "This application is a divisional application of U.S. patent application Serial No. 09/910,641, filed on July 20, 2001, which is a continuation-in-part of provisional application US serial No. 60/220,357 filed July.....".

The 0001 paragraph of the specification has been changed throughout prosecution without proper amendments.

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: claim 1 does not have proper antecedent basis from the specification for the following terms “attachment engaging surface is covered through with a layer of either hooks or piles”, “planar body engaging surface”, “a pair of flexible backings having different types of adhesives disposed thereon”, “wherein one type of adhesive is a re-useable adhesive” and “another type of adhesive is a waterproof adhesive for cooperating with said pair of backings to form a waterproof barrier between the skin of a user and the layer of hooks or piles”.

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: in claim 21, there is no support in the disclosure for “non-skin irritating adhesive”.

Examiner notes that the exact wordage of “non-skin irritating adhesive” in the claims needs to have proper antecedent basis in the specification.

5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction

of the following is required: claim 22 does not have proper antecedent basis in the specification for “one of said pair of backings”, “the other of said pair of backings”, “a waterproof acrylate adhesive” and “transfer tap to facilitate forming said waterproof barrier”.

6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: in claims 23, there is no support in the disclosure for “waterproof acrylate adhesive to facilitate formation of said waterproof barrier”.

Examiner notes that the exact wordage of “waterproof acrylate adhesive means to facilitate formation of said waterproof barrier” needs to have prior antecedent basis in the specification.

7. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: claim 24 does not have proper antecedent basis for “reusable” and “pair of flexible backings having different types of adhesives disposed thereon” in the specification.

8. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: claim 32 lacks proper antecedent basis for the terms “layered waterproof adhesive construction”, “wherein said layered waterproof adhesive construction includes” and “**a first layer of aattached to said top surface.....a**

second layer of a polyurethane backing with one of it's surface coated with an acrylate adhesive for fixing it to said first layer".

Claim Rejections - 35 USC § 112

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support in the specification for "another type of adhesive is a waterproof adhesive for cooperating with said pair of backings to form a waterproof barrier between the skin of a user and said layer of hooks or piles.".

11. Claim 16 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. there is no support for the attachment engaging surface including decorative indicia.

With respect to Applicant's arguments that the attachment engaging surface includes decorative indicia is not new matter.

*Examiner notes that the attachment engaging surface is covered throughout with a layer of either hooks or piles. The hook or piles as the attachment engaging surface was never described in the originally filed disclosure as having a decorated textured finish. The original claim 2 that Applicant draws attention to for support discusses a decorated textured surface on a pad bottom, but as disclosed in the specification this is relating to the pad embodiment without the thistle cloth layer on the bottom. Further, Examiner notes that the term **hook or piles** providing the pad with decorative indicia does not have proper antecedent basis in the specification.*

12. Claim 24 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support for "a pair of flexible backings being a strip of polyurethane tape with two layers waterproof adhesive and another layer of polyurethane tape with a reusable adhesive layer".

13. Claim 26 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support for the hard shell pre-formed cupped pad being selected for the toes or animal pads. The only disclosure for use of the hard shell pad is on the knees, elbows or shins.

Examiner notes that even through the specification details that the protective shell can be made in a variety of sizes to fit differently sized adults and children, it does not address the use on toes or animal pads. The disclosure for the pads to be worn on the toes or as animal pads is drawn to the embodiment other than that with the protective shell. The use of the protective shell in animal pads and for toes is not disclosed.

14. Claim 27 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support for the layer of hooks or piles provided a decoration.

*Examiner notes that the hook or piles providing a decoration was never described in the originally filed disclosure. The original claim 2 that Applicant draws attention to for support discusses a decorated textured surface on a pad bottom, but as disclosed in the specification this is relating to the pad embodiment without the thistle cloth layer on the bottom. Further, Examiner notes that the term **hook or piles** provided on the pad with decorative indicia does not have proper antecedent basis in the specification.*

15. Claim 28 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one

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skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support for the hard shell pre-formed pad providing decoration to the user's selected body part.

Examiner notes that the specification details the use of a decorated pad surface, but does not disclose a decorated pad surface with the hard shell pre-formed pad. The pad 10 as discussed in paragraph 0039 of Applicant's specification details a pad made out of ethylene vinyl acetate, not a hard shell pre-formed pad.

16. Claim 29 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support for the hook or piles having a decoration consisting of color, pattern, graphic design, text, advertising and relief design.

*Examiner notes that the hook or piles providing a decoration consisting of color, pattern, graphic design, text, advertising and relief design was never described in the originally filed disclosure. The original claim 2 that Applicant draws attention to for support discusses a decorated textured surface on a pad bottom, but as disclosed in the specification this is relating the pad embodiment without the thistle cloth layer on the bottom. Further, Examiner notes that the term **hook or piles** provided on the pad with decorative indicia does not have proper antecedent basis in the specification. Further, Examiner notes that the specification details the use of a decorated pad surface, but*

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does not disclose a decorated pad surface with hook or loop piles of the thistle cloth layer. The pad 10 as discussed in paragraph 0039 of Applicant's specification details a pad made out of ethylene vinyl acetate, not a thistle cloth layer.

17. Claim 32 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support for "a layer of thistle cloth providing the pad with a decorated textured finish", "the top surface covered by a layer of water proof adhesive construction" and "said layered waterproof adhesive construction".

Examiner notes that the layer of thistle cloth providing a decoration was never described in the originally filed disclosure. The original claim 2 that Applicant draws attention to for support discusses a decorated textured surface on a pad bottom, but as disclosed in the specification this is relating to the pad embodiment without the thistle cloth layer on the bottom. The specification details the use of a decorated pad surface, but does not disclose a decorated pad surface with the thistle cloth layer. The pad 10 as discussed in paragraph 0039 of Applicant's specification details a pad made out of ethylene vinyl acetate, not a thistle cloth layer.

18. Claim 34 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one

skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. there is no support for the thistle cloth layer providing the pad with a decorated textured finish.

Examiner notes that the layer of thistle cloth providing a decorated textured finish was never described in the originally filed disclosure. The original claim 2 that Applicant draws attention to for support discusses a decorated textured surface on a pad bottom, but as disclosed in the specification this is relating to the pad embodiment without the thistle cloth layer on the bottom. The specification details the use of a decorated pad surface, but does not disclose a decorated pad surface with the thistle cloth layer. The pad 10 as discussed in paragraph 0039 of Applicant's specification details a pad made out of ethylene vinyl acetate, not a thistle cloth layer.

Double Patenting

1. Claims 1, 5, 13-18, 21, 27 and 32-35 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 21, 22, 23, 27, 29 and 32 of copending Application No. 09/910,641 in view of Hattori (US 4,553,550).

In regard to claim 1, 09/910,641 teaches a novelty fashion wear item. A flexible pad having a planar body engaging surface and an attachment engaging surface. The planar body engaging surface is coated throughout with reusable adhesive means for removably securing the pad to a body part (claims 21-23).

However, 09/910,641 fails to teach the attachment engaging surface is covered through with a layer of either hooks or piles for providing the pad with a decorated textured finish.

Hattori teaches an adhesive pad for attachment the skin of a user. The attachment engaging surface is covered through with a layer of either hooks or piles and provides the pad with a decorated textured finish (figure 4c).

In regard to claim 5, 09/910,641 teaches the pad is a single piece construction composed of a cushioning material (claims 21-23).

In regard to claim 13, 09/910,641 teaches the pad is sufficiently flexible to conform to the contour of a user selected body part consisting of a group of body parts selected from the hands, fingers, feet toes, knees and elbows or a user to provide protection for the body part selected (claims 21-23 and 29).

In regard to claim 14, Hattori teaches the pad being made of fabric (column 5, lines 65-67).

In regard to claim 15, 09/910,641 teaches the pad capable of being trimmable and disposable after use (claims 21-23).

In regard to claim 16, 09/910,641 teaches the attachment engaging surface including decorative indicia (claims 21-23 and 32).

In regard to claim 17, 09/910,641 teaches the pad being composed of a body protecting material (claims 21-23).

In regard to claim 18, 09/910,641 teaches the pad being composed of a cushioning material.

In regard to claim 21, 09/910,641 teaches the adhesive means being a non-irritating adhesive (claim 23).

In regard to claim 27, Hattori teaches the hook or piles providing a textured pattern decoration (figure 4c).

In regard to claim 32, 09/910,641 teaches a novelty fashion wear item. A flexible pad having a top surface covered by a layer of adhesive and a bottom surface (figures 21-23).

However, 09/910,641 fails to teach the bottom surface of the pad being at least partially covered with a layer of thistle cloth for providing the pad with a decorated texture finish.

Hattori teaches a pad having a bottom surface being at least partially covered with a layer of thistle cloth for providing the pad with a decorated texture finish (figure 4c).

In regard to claim 33, Hattori teaches the thistle cloth is a complimentary thistle cloth for engaging another layer of thistle cloth (figures 5a, 5b).

In regard to claim 34, Hattori teaches the another layer of thistle cloth providing the pad with a decorated textured finish (figure 4c).

In regard to claim 35, Hattori teaches the another layer of thistle cloth being affixed to a protective shell for protecting a body part from direct ground contact (Figure 9a).

It would have been obvious to have provided the adhesive pad of 09/910,641 with the hook or piles attachment surface of Hattori, since the adhesive pad of

09/910,641 with hook or piles attachment surface would provide a pad that is capable of securing additional layers to the pad based on desired end use.

This is a provisional obviousness-type double patenting rejection.

2. Claims 1, 5, 13-18, 21-24, 27 and 32-35 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 52-57, 59-68 and 73-74 of copending Application No. 10/454,236 in view of Hattori.

In regard to claim 1, 10/454,236 teaches a novelty fashion wear item. A flexible pad having a planar body engaging surface and an attachment engaging surface. The planar body engaging surface is coated throughout with reusable adhesive means for removably securing the pad to a body part (claims 52, 73).

However, 10/454,236 fails to teach the attachment engaging surface is covered through with a layer of either hooks or piles for providing the pad with a decorated textured finish.

Hattori teaches an adhesive pad for attachment the skin of a user. The attachment engaging surface is covered through with a layer of either hooks or piles and provides the pad with a decorated textured finish (figure 4c).

In regard to claim 5, 10/454,236 teaches the pad is a single piece construction composed of a cushioning material (claim 65).

In regard to claim 13, 10/454,236 teaches the pad is sufficiently flexible to conform to the contour of a user selected body part consisting of a group of body parts selected from the hands, fingers, feet toes, knees and elbows or a user to provide protection for the body part selected (claims 52-54).

In regard to claim 14, Hattori teaches the pad being made of fabric (column 5, lines 65-67).

In regard to claim 15, 10/454,236 teaches the pad capable of being trimmable and disposable after use (claims 52, 73).

In regard to claim 16, 10/454,236 teaches the attachment engaging surface including decorative indicia (claims 55, 61).

In regard to claim 17, 10/454,236 teaches the pad being composed of a body protecting material (claims 52, 73).

In regard to claim 18, 10/454,236 teaches the pad being composed of a cushioning material (claims 52, 73).

In regard to claim 21, 10/454,236 teaches the adhesive means being a non-irritating adhesive (claim 68).

In regard to claim 22, 10/454,236 teaches the reusable adhesive means is layered adhesive means. A two sided acrylic pressure sensitive adhesive transfer tape attached to the body engaging surface and a polyurethane backing with one of its surfaces coated with an acrylate adhesive for fixing it to the two sided acrylic pressure sensitive transfer tape (claims 52, 54, 73).

In regard to claim 23, 10/454,236 teaches the reusable adhesive means being a layered waterproof means and therefor also a sweat barrier (claims 52, 73).

In regard to claim 24, 10/454,236 teaches a layered sweat barrier. A strip of polyurethane tape having a pad facing surface and a body part facing surface. The body part facing surface being coated with a layer of waterproof adhesive and the pad facing

surface being coated with another layer of waterproof adhesive for securing the strip of polyurethane tape to the body engaging surface. Another strip of polyurethane tape having another pad facing surface and another body part facing surface. The another body part facing surface is coated with a skin compatible reusable adhesive layer for facilitating removably securing the pad to the user selected body part. The strip of polyurethane tape and the another strip of polyurethane tap are secured to one another by the layer of waterproof adhesive disposed on the body part facing surface of the strip of polyurethane tape (claims 52, 54, 73).

In regard to claim 27, Hattori teaches the hook or piles providing a textured pattern decoration (figure 4c).

In regard to claim 32, 10/454,236 teaches a novelty fashion wear item. A flexible pad having a top surface covered by a layer of adhesive and a bottom surface (claim 52, 73).

However, 10/454,236 fails to teach the bottom surface of the pad being at least partially covered with a layer of thistle cloth for providing the pad with a decorated texture finish.

Hattori teaches a pad having a bottom surface being at least partially covered with a layer of thistle cloth for providing the pad with a decorated texture finish (figure 4c).

In regard to claim 33, Hattori teaches the thistle cloth is a complimentary thistle cloth for engaging another layer of thistle cloth (figure 5a, 5b).

In regard to claim 34, Hattori teaches the another layer of thistle cloth providing the pad with a decorated textured finish (figure 5a, 5b).

In regard to claim 35, Hattori teaches the another layer of thistle cloth being affixed to a protective shell for protecting a body part from direct ground contact (figure 9a).

It would have been obvious to have provided the adhesive pad of 10/454,236 with the hook or piles attachment surface of Hattori, since the adhesive pad of 10/454,236 with hook or piles attachment surface would provide a pad that is capable of securing additional layers to the pad based on desired end use.

This is a provisional obviousness-type double patenting rejection.

With respect to the above provisional obviousness-type double patenting rejections, the Examiner acknowledges applicant's statement that should the 10/454,236 and/or the 09/910,641 ripen into an issued patent prior to the present application being allowed Applicant will respond to these rejections or in the alternative file a terminal disclaimer.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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4. Claims 1, 5, 13-18, 21-24 27 and 32-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hattori in view of Mower (US 3,092,103).

In regard to claim 1, Hattori teaches a novelty fashion wear item. A flexible pad having a planar body engaging surface and an attachment engaging surface being covered throughout with a layer of either hooks or piles. The planar body engaging surface is coated throughout with reusable adhesive means for removably securing the pad to a body part. Further, Hattori teaches an adhesive pad for attachment the skin of a user. The attachment engaging surface is covered through with a layer of either hooks or piles and provides the pad with a decorated textured finish (figure 4c).

However, Hattori fails to teach the layered waterproof adhesive construction. The construction consisting of a pair of flexible backings having different types of adhesives disposed thereon. One of the backings having a waterproof adhesive for cooperating with the pair of backings to form a waterproof barrier between the skin of a user and the layer of hooks or piles.

Mower teaches an adhesive that is capable of being reused. The layered adhesive means that is waterproof (see figure 3). A two-sided pressure sensitive adhesive transfer tape attached to the body engaging surface and a waterproof film backing with one of it's surfaces coated with a adhesive to affix to the transfer tape (column 2, lines 36-52). Further, the backing of Mower has an adhesive to be compatible with a user's skin (column2, lines 64-69).

Examiner notes that the additional claim language to claim 1 is not supported in the specification. Further, Applicant has not provided any critical unexpected results

arising from using the adhesive layered construction as claimed. The only mention of a layered adhesive construction is in paragraph 0028 of applicant's specification which gives an example of a pad construction without detailing the necessities of any of the particular materials or layering placement. In as such, any construction that adheres a pad to the user's skin would provide the same properties as required in applicant's specification.

In regard to claims 22 and 24, Mower teaches a layered adhesive means that by nature of the adhesive is waterproof and would form a waterproof barrier (see figure 3). A two-sided pressure sensitive adhesive transfer tape attached to the body engaging surface and a waterproof film backing with one of it's surfaces coated with a adhesive to affix to the transfer tape (column 2, lines 36-52). Further, the backing of Mower has an adhesive to be compatible with a user's skin (column 2, lines 64-69). Skin compatible adhesives are capable of being re-usable.

It would have been obvious to have provided the pressure sensitive adhesive transfer tape with two or one sided adhesive because as long as the transfer tape is attached to the waterproof film or polyurethane backing, the number of layers of adhesive are irrelevant.

It would have been further obvious to have provided the adhesive on the transfer tape being an waterproof acrylic adhesive or any other adhesive as long as the adhesive secures that transfer tape to the pad body and to the waterproof film.

It would have been obvious to have provided the backing to be made out of polyurethane or from vinyl, polyethylene, acetate film or polyester film, because as long

as the backing provides a waterproof barrier the type of material can be chosen from many well known in the apparel arts.

In the amendment to claim 24, Applicant has added “wherein said pair of flexible backings having different types of adhesives disposed thereon includes:..”

Examiner notes that the specification does not discuss anything about “backings”. Further, the specification does not provide any critical unexpected results arising from the backings having two different types of adhesives disposed thereon. The only mention of a layered adhesive construction is in paragraph 0028 of applicant’s specification which gives an example of a pad construction without detailing the necessities of any of the particular materials or layering placement. In as such, any construction that adheres a pad to the user’s skin would provide the same properties as required in applicant’s specification.

In regard to claim 5, Hattori teaches the pad is a single piece construction composed of a cushioning material (column 5, lines 65-67).

In regard to claim 13, Hattori teaches the pad is sufficiently flexible to be capable of conforming to the contour of a user’s selected body part consisting of the hands, fingers, feet toes, knees and elbows or a user to provide protection for the body part selected (figures 1-38).

In regard to claim 14, Hattori teaches the pad being made of fabric (column 5, lines 65-67).

In regard to claim 15, Hattori teaches the pad capable of being trimmable and disposable after use (column 5, lines 65-67).

In regard to claim 16, Hattori teaches the attachment engaging surface including decorative indicia (figure 4c).

In regard to claim 17, Hattori teaches the pad being composed of a body protecting material (column 5, lines 65-67).

In regard to claim 18, Hattori teaches the pad being composed of a cushioning material (column 5, lines 65-67).

In regard to claim 21, Hattori teaches the adhesive means being a non-irritating adhesive (column 8, lines 29-49).

In regard to claim 27, Hattori teaches the hook or piles providing a textured pattern decoration (figure 4c).

In regard to claim 23, with respect to the pair of flexible backings being fixed together by a waterproof acrylate adhesive to facilitate formation of said waterproof barrier.

Examiner notes that the specification does not describe why a pair of flexible backings have to be fixed together by a waterproof acrylate adhesive to form a waterproof barrier. The specification is silent about waterproof adhesives and barriers. As long as the layered adhesive pad has hook and piles and can be adhered to the users' skin it can have any adhesive construction that is well known in the arts to secure items to user's skin.

In regard to claim 32, Hattori teaches a novelty fashion wear item. A flexible pad (3) having a top surface covered by a layer of adhesive (5) and a bottom surface (figure

4c). A bottom surface being at least partially covered with a layer of thistle cloth (10) for providing the pad with a decorated texture finish (figure 4c).

However, Hattori fails to teach the layered waterproof adhesive construction wherein said layered waterproof adhesive construction includes a first layer of a two sided acrylic pressure sensitive adhesive transfer tape attached to the top surface and a second layer of a polyurethane backing with one of it's surfaces coated with an acrylate adhesive for fixing to said first layer.

Mower teaches a layered adhesive means that by nature of the adhesive is waterproof and would form a waterproof barrier (see figure 3). A two-sided pressure sensitive adhesive transfer tape attached to the body engaging surface and a waterproof film backing with one of it's surfaces coated with a adhesive to affix to the transfer tape (column 2, lines 36-52). Further, the backing of Mower has an adhesive to be compatible with a user's skin (column 2, lines 64-69). Skin compatible adhesives are capable of being re-usable.

The specification does not provide any critical unexpected results arising from the first and second layer having two different types of adhesives disposed thereon. The only mention of a layered adhesive construction is in paragraph 0028 of applicant's specification which gives an example of a pad construction without detailing the necessities of any of the particular materials or layering placement. In as such, any construction that adheres a pad to the user's skin would provide the same properties as required in applicant's specification.

In regard to claim 33, Hattori teaches the thistle cloth is a complimentary thistle cloth for engaging another layer of thistle cloth (figure 5a, 5b).

In regard to claim 34, Hattori teaches the another layer of thistle cloth providing the pad with a decorated textured finish (figure 5a, 5b).

In regard to claim 35, Hattori teaches the another layer of thistle cloth being affixed to a protective shell for protecting a body part from direct ground contact (figure 9a).

It would have been obvious to have provided the adhesive pad with hook and piles of Hattori with the layered adhesive as taught in Mower, because the adhesive pad of Hattori provided with a layered adhesive would provide a pad with waterproof adhesive means for optimal performance during swimming or activities involving perspiration.

5. Claims 26, 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hattori and Mower in view of Larsson (US 5,032,103).

Hattori and Mower fail to teach an adhesive pad as described above in claim 1. The pad of Hattori and Mower is capable of being applied to the user's toes, knees, elbows and animal pads as desired. Additionally, Hattori and Mower teaches a pad with hooks or piles that are complimentary to another portion having hook or piles.

However, Hattori and Mower fail to teach a hard shell pre-formed cupped pad having a predefined shape, wherein the hard shell pre-formed cupped pad has another layer of either hooks or piles for engaging at least a portion of the layer of either hooks

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or piles secured to the bottom surface. The layer of hook or piles would inherently add further decoration to the pad as a pattern textured decoration.

Larsson teaches a hard shell pre-formed cupped pad having a predefined shape (figures 1-4: column 2, lines 42-49).

It would have been obvious to have provided the adhesive pad of Hattori and Mower that is connectable to a breast covering by complimentary hooks or piles, since the adhesive pad of Hattori and Mower provided with a hard shell pre-formed shaped breast covering would provide a pad that further protects the user from not only impact but sharp objects greatly protecting the user's breast below.

Response to Arguments

6. Applicant's arguments filed 04/29/06 have been fully considered but they are not persuasive.

I.) Applicant argues that the prior art of Hattori (US 4,553,550) fails to follow

"a pair of flexible backings having different types of adhesives disposed thereon...."

Examiner notes that the specification does not discuss anything about "backings". Further, the specification does not provide any critical unexpected results arising from the backings having two different types of adhesives disposed thereon. The only mention of a layered adhesive construction is in paragraph 0028 of applicant's specification which gives an example of a pad construction without detailing the necessities of any of the particular materials or layering placement. In as such, any

construction that adheres a pad to the user's skin would provide the same properties as required in applicant's specification.

"wherein one type of adhesive is a re-usable adhesive for removably securing said pad to a body part"

Examiner notes that any adhesive is capable of being re-used. Until the adhesive become incapable of sticking to the skin of the user the adhesive could be coupled to a body part removed and coupled to the same or different body part as desired.

"wherein another type of adhesive is a water resistant adhesive for cooperating with said pair of flexible backings to from a waterproof barrier between the skin of a user and said layer of hooks and piles"

Examiner notes that the specification does not discuss anything about "backings". Further, the specification does not provide any critical unexpected results arising from the backings having two different types of adhesives disposed thereon. The only mention of a layered adhesive construction is in paragraph 0028 of applicant's specification which gives an example of a pad construction without detailing the necessities of any of the particular materials or layering placement. In as such, any construction that adheres a pad to the user's skin would provide the same properties as required in applicant's specification.

"a layered waterproof adhesive construction"

Examiner notes that the term waterproof has not been disclosed in Applicant's specification. The specification does not provide any critical unexpected

results airing from the layered waterproof adhesive construction. The only mention of a layered adhesive construction is in paragraph 0028 of applicant's specification which gives an example of a pad construction without detailing the necessities of any of the particular materials or layering placement. In as such, any construction that adheres a pad to the user's skin would provide the same properties as required in applicant's specification.

"a first layer of a two sided acrylic pressure sensitive adhesive transfer tape attached to said top surface..."

Applicant's specification does not discuss the criticality of a first layer of a two sided acrylic pressure sensitive adhesive transfer tape attached to said top surface. Further, in the rejection Mower is used to show a teaching of a two sided pressure sensitive adhesive attached to a pad.

"a second layer of a polyurethane backing with one of its surfaces coated with an acrylate adhesive for fixing to said first layer."

Applicant's specification does not discuss the criticality or an unexpected results arising from a second layer of polyurethane backing with one of it's surfaces coated with an acrylate adhesive for fixing to said first layer. Further, in the rejection Mower is used to show a teaching of a two sided pressure sensitive adhesive attached to a pad with a waterproof backing.

II) Applicant argues that the combined teachings of Hattori and Larsson do not provide a proper *prima facie* case of obviousness.

The Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the references be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPPA 1969). In this case, it is the Examiner's position that one having ordinary skill in the art would have found it obvious to combine the adhesive pad of Hattori that is connectable to a breast covering by complimentary hook or piles, since the adhesive pad of Hattori provided with a hard shell pre-formed shaped breast coverings would provide a pad that further protects the breast and nipple from irritation. Support for the motivation can be found in Larsson (US 5,032,103) column 1, lines 5-9 and 19-33).

III) Applicant argues that the combined teachings of Hattori and Mower do not provide a proper *prima facie* case of obviousness.

The Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the references be expressly articulated. The test for combining references is what the

combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPPA 1969). In this case, it is the Examiner's position that one having ordinary skill in the art would have found it obvious to combine the adhesive pad of Hattori that is connectable to a breast covering by complimentary hook or piles provide with the layered adhesive construction of Mower, since the pad of Hattori provided with the layered construction would provide a pad to insure better anchorage of the patch in place on the user's skin and also provide greater protection of the body part under the pad due to the adhesive layer and waterproof film construction.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

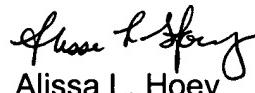
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alissa L. Hoey whose telephone number is (571) 272-4985. The examiner can normally be reached on M-F (8:00-5:30)Second Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Welch can be reached on (571) 272-4996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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